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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,228	10/27/1999	FIROOZ GHASSABIAN	676-8CIP	4391

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/428,228

Applicant(s)

GHASSABIAN, FIROOZ

Examiner

Eliseo Ramos-Feliciano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26 and 28-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26 and 28-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. New corrected drawings are required in this application because the drawings filed October 27, 1999 are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 – 1st

2. *Previous 35 USC 112 – 1st paragraph rejection is withdrawn in view of applicant's amendment filed October 28, 2004.*

Claim Rejections - 35 USC § 112 – 2nd

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 26, 32-36, 42 and 43** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Claim 26** recites the limitation "said antenna" in lines 3, 5, and 7 as amended. There is insufficient antecedent basis for this limitation in the claim. For examination on the merits the recitation "said antenna" is being interpreted as --said antenna system--, as earlier in the claim.

6. **Claim 32** includes the same problem: "said antenna" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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7. **Claim 33** recites the limitation "said first antenna" in line 2. There is insufficient antecedent basis for this limitation in the claim.
8. **Claims 34-36** include the same problem: "said first antenna". There is insufficient antecedent basis for this limitation in the claim(s).
9. **Claim 42** recites the limitation "said keypad unit and said watch unit" making reference to claims 40 and 29 in cumulative form since the keypad unit only appears in claim 40, while the watch unit only appears in claim 29. However, the claim depends on claims "40 or 29" in the alternative. This is contradictory; therefore, indefinite. In addition, applicant is advised that cumulative claiming is not permitted – MPEP 608.01(n).
10. **Claim 43** recites the limitation "said display unit and said watch unit" making reference to claims 41 and 29 in cumulative form since the display unit only appears in claim 41, while the watch unit only appears in claim 29. However, the claim depends on claims "41 or 29" in the alternative. This is contradictory; therefore, indefinite. In addition, applicant is advised that cumulative claiming is not permitted – MPEP 608.01(n).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 26, 29, 31, 34-35 and 40-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (US Patent Number 6,112,054) in view of Pequignet (US Patent Number 5,631,879).

Regarding **claim 26**, Kita discloses a wrist-mounted communication device (wrist watch – Figures 30-31) for attaching to a wearer's wrist (column 39, lines 47-49), the device comprising an antenna system (141) having at least a first section (142) coupled to said device and configured to transmit and receive communication signals (column 40, lines 3-6), said antenna having an openable cover (118 – column 39, line 57) and a biasing mechanism (depicted in Figures 30-31) wherein said openable cover (118) holds said antenna (141) in horizontal plane position of said wrist-mounted communication device when said device is not in use by a user (for example, closed position), said biasing mechanism, when said openable cover is removed (for example, open position), automatically releases said antenna to a desired position away (see for example Figure 31) from said horizontal plane when said wrist communication device is in use by said user.

However, Kita fails to specify that the biasing mechanism releases the antenna to the desired position automatically as claimed. For example, by automatically opening cover 118. Given that Kita's antenna 141 is included with the cover 118, by automatically opening the cover, the antenna would be released to the desired position automatically.

In the same field of endeavor, Pequignet discloses a wrist watch (Figure 5) having an openable cover (30) and a biasing mechanism (spring 34, 35) for automatically opening the cover upon pressing a button (60). See abstract, and column 3, lines 44-46. One advantage of Pequignet's invention is to make it easier for the user to open the cover and make it more attractive for sales.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to automatically open Kita's cover by applying Pequignet's teachings because this would make it easier for the user to open the cover and more attractive for sales.

Regarding **claims 29 and 40-41**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). In addition, Kita discloses that the wrist-mounted communication device further comprises a watch unit (column 39, line 48-50), a keypad (117 – Figure 30), and a display (118 – Figure 30). Pequignet also discloses a watch unit (abstract, Figure 5).

Regarding **claim 31**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). However, they fail to specify the particular materials used to manufacture the back of the openable cover and the external part of the wrist-mounted communication device.

The examiner contends that the particular materials used to manufacture the subject product would be a choice of engineering design that would consider esthetical impact in order to make the product more attractive to buyers.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the best engineering design choice to use appropriate materials as claimed for the advantage of making the product more attractive to buyers.

In addition, Kita indirectly discloses that when said openable cover is positioned on said wrist communication device, the entire communication device appears in a uniformly integrated arrangement (Figures 30-31 show cover 118 in open position; it is not difficult to figure out how it looks in closed position).

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Regarding **claim 34**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). In addition, Kita discloses at least a second antenna (124) configured to operate independently from said first antenna (141).

Regarding **claim 35**, Kita and Pequignet disclose everything claimed as applied above (see *claim 34*). However, they fail to specify that the antennas can operate as a diversity antenna.

The examiner contends that diversity is well known for improved signal quality. Given the fact Kita already teaches two distinct antennas, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to operate them as a diversity antenna for the advantage of better communication quality.

13. **Claims 28 and 38-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Pequignet as applied to *claim 26, 29 respectively*, above, and further in view of Seymour (US Patent Number 6,529,713).

Regarding **claim 28**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). However, they fail to specifically disclose that the openable cover is a removable handset of said wrist-mounted communication device as defined by applicant.

In the same field of endeavor, Seymour discloses a wrist-mounted communication device (radio handset – Figure 6) including an openable cover (6 and 7) that is a removable handset (column 5, lines 5-9). One advantage of Seymour is to allow the user to place the headset closer to the ear in a more comfortable manner.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the openable cover a removable handset of the wrist-mounted

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communication device because this would allow the user to place the headset closer to the ear in a more comfortable manner.

Regarding **claims 38-39**, Kita, Pequignet and Seymour disclose everything claimed as applied above (see *claims 28 and 29 respectively*). In addition, Seymour discloses that the handset is a multi-sectioned handset (fairly characterized as “multi-sectioned keypad” too) comprising at least two sections (section 6 and section 7) configured to move between a closed position and an open position (Figure 6), wherein in closed position said multi-sectioned handset is adapted to be as small as the largest section, and wherein in open position said sections of said multi-sectioned handset expand to provide an extended handset (Figure 3).

14. **Claims 30 and 42-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Pequignet as applied to *claims 29, 40 and 41 respectively*, above, and further in view of Kivelä (US Patent Number 6,529,713).

Regarding **claims 30 and 42-43**, Kita and Pequignet disclose everything claimed as applied above (see *claims 29, 40 and 41 respectively*). However, they fail to specifically disclose that while attached to said wrist-mounted communication device, said cover and said watch unit are in opposite relationship on a user's wrist as defined by applicant. Nor that the keypad unit and the watch unit are in opposite relationship on a user's wrist. Nor that the display unit and the watch unit are in opposite relationship on a user's wrist.

In the same field of endeavor, Kivelä discloses a wrist-mounted communication device including a wrist-mounted communication device (Figure 2), with a cover (20 – keypad/display units) and a watch unit (opposite side) in opposite relationship on a user's wrist (column 3, lines 20-21; column 4, lines 19-20). Alternatively, the cover (Figure 8b) and the watch unit (8a) are in

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opposite relationship on a user's wrist (note fingers in the figures). One advantage of Kivelä's invention is to improve antenna efficiency (column 6, lines 43-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place the cover (keypad/display) and the watch unit in opposite relationship on a user's wrist as suggested by Kivelä because this would help to improve antenna efficiency as taught by Kivelä.

15. **Claims 32-33 and 36-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Pequignet as applied to *claims 26 and 34 respectively*, above, and further in view of Houlihan (US Patent Number 5,467,324).

Regarding **claim 32**, Kita and Pequignet disclose everything claimed as applied above (see *claim 26*). However, they fail to specifically disclose that the antenna is expandable in its open position.

In the same field of endeavor, Houlihan discloses a wrist-mounted communication device including a cover (336 – Figure 9) that is expandable in its open position (column 5, lines 22-27). One advantage of Houlihan's invention is to better direct antenna radiation away from the user's head.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the antenna is expandable in its open position because this would help to better direct antenna radiation away from the user's head.

Regarding **claim 33**, Kita, Pequignet and Houlihan disclose everything claimed as applied above (see *claim 32*). In addition, Houlihan discloses an expansion antenna (part 332) configured to rotate about said first antenna (see Figure 9; column 5, lines 22-27).

Regarding **claims 36-37**, Kita and Pequignet disclose everything claimed as applied above (see *claim 34*). However, they fail to specifically disclose that one end of said first antenna is coupled to said communication device and the other end of said first antenna is rotatably coupled to one end of said second antenna. Or that one end of said first and second antenna is rotatably coupled to said communication device such that said first and second antennas are adjustable to form an angle in relation to each other.

In the same field of endeavor, Houlihan discloses a wrist-mounted communication device including a cover (336 – Figure 9) that includes an antenna structure, so that that one end of the first antenna (see Figure 9; column 5, lines 22-27) is coupled to the communication device and the other end of the first antenna is rotatably coupled to one end of the second antenna (part 332). Also one end of the first and second antenna is rotatably coupled to the communication device . such that the first and second antennas are adjustable to form an angle in relation to each other. One advantage of Houlihan's invention is to better direct antenna radiation away from the user's head.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the described configuration because this would help to better direct antenna radiation away from the user's head.

Response to Arguments

16. Applicant's arguments with respect to *claims 26, 27-43* have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER



ERF/erf

April 15, 2005


4/18/05
LESTER G. KINCAID
PRIMARY EXAMINER